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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,944	09/22/2003	Sanjay Rastogi	P03118	1627
23702 7590 06/14/2007 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701			EXAMINER VARGOT, MATHIEU D	
			ART UNIT 1732	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/667,944	Applicant(s) RASTOGI ET AL.	
	Examiner Mathieu D. Vargot	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7, 9-13, 15, 25, 26, 29, 36-38, 41 and 44-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7, 9-13, 15, 25, 26, 29, 36-38, 41 and 44-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 41, 45, 49-56 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 41 and 45 are duplicates of each other and this needs to be corrected.

Applicant cannot obtain two distinct claims reciting the same subject matter. Claims 49-52 set forth limitations that apparently are obtained with bifocal lenses. However, these claims are dependent on claims—ie, claims 1 and 7—that do not require the formation of bifocal lenses and hence it would appear that they are improperly dependent. In claims 53-56, --bifocal—should be inserted before “lens” or “contact lens”. Also, there are two claims numbered as claim 60 and this requires correction.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7, 9-13, 15, 25, 26, 29, 36-38, 41 and 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wrue et al essentially for reasons of record noting the following.

Applicant has cancelled a number of dependent claims and incorporated them into independent claims as well as added a number of new dependent claims. However, it is submitted that the claims remain properly rejected, with the aspects of the lens being a bifocal lens, the exact sku values for the lenses and the exact pick yield being within the skill level of the art. Certainly, the instant bifocal contact lenses are known in the art

and one of ordinary skill would have expected that the pick method of Wrue et al would have worked on such lenses.

3. Applicant's arguments filed February 23, 2007 have been fully considered but they are not persuasive. Applicant appears to be alleging unexpected results to define over Wrue et al. Applicant indicates that a similar apparatus to Wrue et al was used in a control, and the control was used to pick **non-bifocal** lenses and worked just fine. When the apparatus of Wrue et al was used to pick bifocal contact lenses with certain characteristics, the conventional nozzle of Wrue et al did not work as well as the present invention. However, such is not probative of unexpected results for these reasons. First of all, Wrue et al has not been directly tested against the instant method. Applicant needs to provide a direct testing wherein the same lenses are tested using the instant method and that of Wrue et al for such to be probative. Also, it should be noted that Wrue et al apparently works very well with non-bifocal lenses, and many of the instant claims are directed to picking these lenses. If claims were to be allowed based on a showing of unexpected results, all the claims would have to be commensurate in scope with the showing. In the instant case, it appears that any unexpected results would be for certain bifocal contact lenses, and such would need to be recited in all the claims.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
June 6, 2007


Mathieu D. Vargot
Primary Examiner
Art Unit 1732
6/6/07